

REMARKS

Applicants have carefully reviewed the Application in light of the Office Action mailed December 9, 2008. Claims 29-55 are pending in this Application. Claims 29-40 were rejected under 35 U.S.C. § 102(e), Claims 41-55 stand rejected under 35 U.S.C. § 103(a), and Claims 30 and 35 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 29-36, 38-49, and 51-53 have been amended. Applicant respectfully requests reconsideration and favorable action in this case.

Claim Objections

Claims 31, 36, 42-45, 47 and 51-53 were objected to for lack of antecedent basis. Applicants have amended Claims 31, 36, 42-45, 47 and 51-53 accordingly. Applicants respectfully request the withdrawal of the claim objections.

Rejections under 35 U.S.C. § 112

Claims 30 and 32-35 were rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claims 30 and 32-35 to overcome these rejections and respectfully request the withdrawal of the rejection under 35 U.S.C. § 112.

Rejections under 35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Claims 29-40 were rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0265525 filed by Fei Tang *et al.* (“*Tang*”).

Applicants respectfully traverse and submit that the cited art does not constitute as prior art under 35 U.S.C. § 102(e), which states in relevant part with emphasis added:

A person shall be entitled to a patent unless . . . the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States *before* the invention by the applicant for patent . . .

Applicants claim priority to German application DE filed on 10325889.2 filed on June 6, 2003. The Examiner acknowledged Applicants’ claim for foreign priority under 35 U.S.C. § 119 and acknowledged the receipt of all relevant supporting documentation. *See* Office Action Summary. The Examiner cites *Tang* as § 102(e) art, but *Tang* was filed in the United States on May 11, 2005 and was published on December 1, 2005, well after Applicants’ priority date. Most importantly, however, *Tang* was not described in an application for patent nor was it published in the United States *before* the invention by Applicants as required under the statute. Therefore *Tang* cannot anticipate Claims 29-40.

Furthermore, Applicants respectfully submit that *Tang* does not teach all of the elements of the claimed embodiment of the invention. For example, amended Independent Claim 29 recites, in part:

creating a plurality of variants of the one or more useful data objects in the switching component as a function of one or more parameters; and
informing the first telecommunication device of the availability of the plurality of variants of the one or more useful data objects for transmission to the first telecommunication device

Referring to Paragraph [0019] relied upon by the Examiner, *Tang* discloses “an originator MMSC receiving a MM submitted by an originator terminal, then editing and generating a routing forward request message.” In Paragraphs [0039] and [0041], also relied upon by the Examiner, *Tang* discloses an originator MMSC “forwards the MM to a recipient MMSC through MM4...the recipient MMSC delivers the MM to a recipient terminal and returns a delivery report to the originator MMSC]” and that the originator MMSC “edits and generates

a routing forward request message MM3...[where] the editing process means to generate a message with standard format specified protocol.” The steps of receiving and editing the MM and then generating a routing forward request message does not include (1) creating a plurality of variants in a switching component as a function of one or more parameters and (2) informing the first telecommunication device (*e.g.*, originator terminal) of the availability of the plurality of variants, as recited in amended Independent Claim 29.

For at least these reasons, *Tang* fails to serve as prior art over amended independent Claim 29. Applicants submit that Claim 29 and all claims that depend therefrom are allowable. Applicants respectfully request that the reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(e) and full allowance of all pending claims.

Rejections under 35 U.S.C. § 103

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Claims 41-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tang* as applied to claim 29 above in view of various combination of U.S. Patent Application Publication No. 2006/0019637 filed by Thomas Becker *et al.* (“*Becker*”) and/or U.S. Patent

Application Publication No. 2003/0096598 filed by Ralf Prenzel *et al.* ("*Prenzel*"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

As noted above, *Tang* fails to teach or suggest all the elements of amended independent Claim 29. *Becker* and/or *Prenzel*, separately or as combined by the Examiner, also fails to teach all the elements of amended independent Claim 29. For example, *Becker* and/or *Prenzel* each fails to teach or suggest (1) creating a plurality of variants of the one or more useful data objects in the switching component as a function of one or more parameters, and (2) informing the first telecommunication device of the availability of the plurality of variants of the one or more useful data objects for transmission to the first telecommunication device, as recited in amended Independent Claim 29.

For at least these reasons, amended independent Claim 29 and all claims that depend therefrom are patentably distinct over the cited references. Applicants respectfully request withdrawal of the rejections under 35 U.S.C § 103(a) and full allowance of all pending claims.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

Respectfully submitted,
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